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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,880	01/19/2001	Chris L. Jones	110163.132US2	9748
7590	01/14/2004		EXAMINER	
Hollie L. Baker Hale and Dorr LLP 60 State Street Boston, MA 02109			SIEW, JEFFREY	
			ART UNIT	PAPER NUMBER
			1637	

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

SA- SM-
Office Action Summary

Application No.

09/766,880

Applicant(s)

JONES ET AL.

Examiner

Jeffrey Siew

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 and 32-66 is/are pending in the application.
- 4a) Of the above claim(s) 25-29 and 64-66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-24 and 42-63 is/are allowed.
- 6) ☒ Claim(s) 30,32,35 and 36 is/are rejected.
- 7) ☒ Claim(s) 33,34,37-41 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Election/Restrictions

1. This application contains claims 25-29 & 64-66 are drawn to an invention nonelected invention. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 30 & 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Binder et al (US6,156,179 Dec. 5, 2000).

Binder et al teach an apparatus for capturing analyte comprising a nonconductive polymeric material for support gel matrix and covalently bound ligand (see whole doc. Esp. Abstract & col. 6 lines 53-60 & col. 7 line 66).

The response filed 10/17/03 to the 102 and 103 rejections has been fully considered and deemed not persuasive. The response states that Binder et al do not teach non conductive polymeric material. Binder et al teach that Bio Rad electrophoresis supplies were used which were made from plastic polymers (see col. 7 line 67). Moreover the plastic beads used in Binder et al would also satisfy the limitation. The 102 and 103 rejections are maintained over the claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 32 & 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Binder et al (US6,156,179 Dec. 5, 2000) in view of Mathies et al (US5,274,240 Dec. 28, 1993).

Binder et al teach an apparatus for capturing analyte comprising a nonconductive polymeric material for support gel matrix and covalently bound ligand (see whole doc. Esp. Abstract & col. 6 lines 53-60).

Binder do not teach gel holder with multiple openings or detectable labels.

Mathies et al teach multiple parallel capillaries for detection (see whole doc. esp. abstract). Mathies et al teach fluorescently labels (see whole doc. esp. abstract).

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One of ordinary skill in the art would have been motivated to combine Binder et al's gel with Mathies et al's apparatus in order to detect multiple analytes. Mathies states that a plurality of capillaries allows side by side detection and simultaneous separations (see abstract). It would have been prima facie obvious to apply Mathies et al's plurality of capillary tubes with Binder et al's gel in order to detect multiple different separations and analytes simultaneously.

Moreover, it would have been prima facie obvious to apply Mathies et al's fluorescently labels to capillary electrophoresis in order to detect specific analytes of interest.

Mathies et al's multiple capillaries read on a capture gel holder with openings.

SUMMARY

4. Claims 1-16, 42,43,44-47, 48-55 are allowable. Claims 33,34,37-41, are free of the prior art but objected to for depending on rejecting claim. There is no prior art that teach or suggest an apparatus with a base having a pair of electrode channels with a different electrode extending through each channel and migration channel extending between the electrode channels with an enlarged slot in the opening of the migration channel . The closest prior art is Harrington et al (US5,837,116 Nov. 17, 1998) who teach a two dimensional electrophoresis apparatus with two electrodes but do not teach or suggest an enlarged slot in migration channel.

Claims 17-24 & 56-63 are allowable. There is no prior art that teach a capture gel holder comprising a handle , a plurality of teeth projecting from the handle at least one of the teeth having a bore through the tooth and a gel matrix overlying the bore. The closest prior art is Rice

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et al (US5,972,188 Oct. 26, 1999) who teach a comb with teeth but do not teach or suggest a teeth with bores with gel.

Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

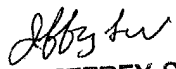
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Siew whose telephone number before January 22, 2003 is (703) 305-3886 and thereafter can be reached at 571-272-0787. The e-mail address is Jeffrey.Siew@uspto.gov. However, the office cannot guarantee security through the e-mail system nor should official papers be transmitted through this route. The examiner is on flex-time schedule and can best be reached on weekdays from 6:30 a.m. to 3 p.m. If attempts to reach the

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examiner are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (703)-308-1119.

Any inquiry of a general nature, matching or filed papers or relating to the status of this application or proceeding should be directed to the Tracey Johnson for Art Unit 1637 whose telephone number is (703)-305-2982.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Center numbers for Group 1600 are Voice (703) 308-3290 and FAX (703)-308-4242.


JEFFREY SIEW
PRIMARY EXAMINER

January 11, 2004